

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

1. Amendments and Support for Same

By the Response, claim 1 has been amended to more particularly point out and distinctly claim the subject matter of the invention. Support for the amended feature can be found in paragraphs [0027] and [0028] and Fig. 2 of US Patent Application Publication No. 2004/0253971 of the present application. No new matter has been added. Accordingly, claims 1-4 are respectfully submitted for consideration. Approval and entry of the amendments are respectfully requested.

2. Rejections under 35 U.S.C. §103(a)

With respect to the rejection of claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over Bontu et al. (US 6,418,137 – hereinafter Bontu) in view of Sakoda et al. (US 6,226,526 – hereinafter Sakoda), Applicant respectfully traverses the rejection at least for the reason that Bontu and Sakoda, combined or separately, fail to teach, disclose, or suggest all of the limitation recited in the rejected claims.

As amended, claim 1 further to clarify the previously amended feature. Particularly, amended claim 1 further clarifies the information generating means configured to generate new control information in accordance with both the supplied direction information and current control information.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Further, according to MPEP §2141(I), Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Moreover, according to MPEP §2141(II), when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Applicant respectfully asserts that both Bontu and Bontu, combined or separately, fail to teach, disclose, or suggest information generating means configured to generate new control information in accordance with both the supplied direction information and current control information, as recited in amended claim 1.

In view of the amendment and arguments set forth above, Applicant respectfully requests reconsideration and withdrawal of the §103(a) rejection of claims 1-4.

3. Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-4 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned at the numbers shown.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,



Luan C. Do
Registration No. 38,434

STUDEBAKER & BRACKETT PC
1890 Preston White Drive, Suite 105
Reston, VA 20191
(703) 390-9051
(703) 390-1277 Fax
luan.do@sbpatentlaw.com